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How to Choose and Protect A Trademark

Modern American Law Lecture

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HOW TO CHOOSE AND PROTECT A TRADEMARK

BY

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Mr. Symons is an attorney-at-law with offices in the McLachlen Building, Washington, D. C. He is also professor of Patent and Trademark law in the Washington College of Law. Before he entered the practice of law, he had been for several years a member of the Examining Corps of the United States Patent Office, and now gives special attention to causes involving the law of Patents, Corporations, Trademarks and Copyrights. He is the author of numerous treatises on these branches of the law, among which are, "The Law of Patents for Designs"; "Copyright of Prints and Labels"; "Some Curious Trademarks"; "Law of Trademarks," and "Law of Copyrights" in Modern American Law.

The State of Ohio can claim Mr. Symons as one of her sons. He was born in Cleveland and educated in the public schools of that State and George Washington University of Washington, D. C., from which he has received three degrees, including Master of Patent Law. Before going to Washington, he was a teacher for three years in the schools of Ohio.

His experience in research work, together with his training in the application of legal principles to close cases, has given him a clear, simple diction in his statement of the rules of law. This Lecture, therefore, is not alone valuable because of its direct bearing upon business, but delightful because of its easy reading style. It will give the reader many new ideas and open up to him the vast field for the use of trademarks.

HOW TO CHOOSE AND PROTECT A TRADEMARK

By

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INTRODUCTION

A good trademark or a distinctive label is now recognized as a valuable asset. To be valuable, however, a trademark must be of a certain character. Some marks do not aid in the sale of the goods upon which they are placed. Other marks, although valuable for a short time, soon cease to be attractive. Marks which are the name of a passing craze are of this character. Great care should therefore be exercised in selecting a trademark. Time spent in determining what mark to adopt is not wasted; investigations made for the purpose of finding out whether the mark one wishes to adopt is in use often prevents loss and expense.

IF THE MARK HAS NOT BEEN SELECTED

If a merchant, a manufacturer or any character of trader or dealer in merchandise has not selected an identifying mark for his goods, and in these days it is considered most desirable to have such a mark in order that his goods may be recognized by the ultimate consumer—how should he proceed in order to obtain a valuable trademark? As much genius was

shown in discovering, selecting and advertising such marks as Kodak, Uneeda, Sapolio and Gold Dust, as was required to produce some of the noted inventions of modern times. Do not think it is easy, therefore, to obtain a good mark.

A mark should be in keeping with the goods. This does not mean that it should describe them. A picture of a dove would obviously be inappropriate as a trademark for steel plates or threshing machines, while it might be a good mark for infants' clothing. The picture of a girl is an appropriate trademark for flour, or hair nets, or hosiery, but it could hardly be successfully advertised as a trademark for felt roofing, saws or plows. Marks which are common and which have been used upon many kinds of goods are not valuable marks to apply to a new line of merchandise. A star for beer is regarded as a mark which anyone may use on that article. Such words as "Excelsior," "Standard" and "Arrow," although well known marks in some lines of trade, have been so widely used that it is doubtful if the public can now be educated to recognize new goods by these old marks. Prize contests to secure a valuable mark have often been resorted to with good results.

INVESTIGATION TO BE MADE

Before adopting a mark, especially if it is to be retained as a permanent mark in a dealer's business, he should have a thorough investigation made to determine if it is in use on goods of the same general kind as the goods upon which he wishes to use it. A search of the records of the United States Patent

Office may first be made to determine if the mark he has in view has been registered. He may make this search in person or employ an attorney or agent to make it for him. There is no fee charged by the government for the privilege of examining its records. A thorough search of the official class of goods in which his particular article is classified may be made, or an examination of the Word and Symbol digest, which takes only a short time, may suffice. Which search should be made depends largely upon the character of the mark.

A general idea of the manner in which the copies of trademark certificates are arranged in the United States Patent Office is advisable.

ARRANGEMENT OF REGISTRATIONS

All registrations are divided into forty-nine classes. This division is made in accordance with the character of the goods upon which marks are used. This division is designated the Digest of Merchandise. The registrations are arranged numerically in these classes. It is sometimes difficult to tell in which one of two or more of the forty-nine official classes a trademark owner's goods should be classified. In such a case, as there is no public official index showing the proper classification of particular goods, search should be made through the classes which are closely related and in one of which the goods should be classified. This search in some of the classes requires a day or more, even for one fairly expert. The Word and Symbol Digest is based upon the character of the marks without regard to the goods upon which they are affixed. The word marks are all arranged in dictionary order and sealed

in packages of convenient size. The symbols are divided into Animate and Inanimate. The Animate are subdivided into Human, Animal, Vegetable and Mythological. Some of these subclasses are further divided in a manner which is easily understood on inspection of the digest. The Inanimate symbols are subdivided into "Articles of Manufacture" and "Objects Not Articles of Manufacture." The latter is again subdivided into convenient groups. This Word and Symbol Digest enables a fairly accurate search to be made in a short time.

To make a search to find out whether the mark under consideration has been registered in any of the states of the United States involves considerable trouble and expense. Only in exceptional cases would the result justify so extensive an investigation as would be necessary to be sure that the mark had not been registered in any of the states. An examination of the appropriate records of the state in which the person interested is located and probably of the adjoining states is sometimes advisable.

A very important source of information is the trade catalogues which have been published in nearly all the important lines of trade. These catalogues contain an alphabetical list of all the known marks used on a particular class of goods. Catalogues of the soap and tobacco trade, for instance, show long lists of marks in use.

There are in the United States several widely known private registration bureaus for the registration of trademarks. These bureaus have various ways of securing knowledge of "going" trademarks.

Some register the mark of an applicant for a small fee, advising him before doing so if the mark is in use by another; other registration companies agree to advise a registrant with them of any infringement of their subscribers' marks. The information in the possession of these bureaus therefore sometimes justifies obtaining information from them.

Trade journals which contain advertisements of the goods of the kind on which the investigator's mark will be used may be examined to good advantage.

An exhaustive search to determine whether the mark is in use is advisable in order to avoid the following condition which has often occurred. A fruit grower or dealer, for instance, commences business in a small way in Florida, using his mark on various kinds of citrus fruits. By skill, industry and honest dealing he establishes in a few years a good reputation for his fruits under his trademark by which the purchasing public has begun to recognize his goods. His trademark, which has now become valuable, is the crystallized good will of his business. Others are now willing to advance him capital on the reputation he has established and he is enabled to enlarge and extend his business. In preparing to do so he spends relatively large sums on boxes, wrappers, cartons, stencils, plates and advertising. Just as he is ready to go into the broader field which success has entitled him to enter, a competitor who may be located in California, discovers the Florida dealer's use of his mark which he has used continuously from a prior date. Under these

circumstances the successful Florida dealer must either buy out his California competitor or stop using his mark. To do the former may be expensive if the California trader has established a reputation for his fruit or has investigated the value to the Florida dealer or of his use of it. To change his mark results in the loss of all paraphernalia, stock of labels, cartons and the advantages of careful advertising. The conditions described here often occur. This unfortunate position of the owner of a mark might have been avoided by proper investigation before use was begun.

MARKS WHICH SHOULD NOT BE ADOPTED

Public Insignia and Marks Against Public Policy. —Although there are some valuable marks in use which consist of public insignia, such as a flag or a coat of arms, or which consist in part of public insignia, it is not regarded as good policy now to adopt such a mark. Strong efforts are being made to have a Federal law passed prohibiting the use in trade of the flag of the United States as a trademark. Even if such a law is not passed, public sentiment against what is in some quarters regarded as desecration of the flag condemns the use of the flag of the Nation as a mere trademark for an article of manufacture. Public insignia marks are not registrable under the Federal trademark law. This fact should be enough to deter anyone who has any foreign business from using such a mark, for without registration in the home country, registration may be obtained in very few instances in a foreign country, and without such registration the mark may not generally be

protected in a foreign country. Some courts of equity have gone so far as to refuse protection to a mark containing national flags on the ground that as the trademark law of the United States does not permit registration of a mark of this character, it is contrary to the public policy of this country to give protection to such marks.

A picture of an ex-president of the United States, whether he be living or dead, is a good mark in some respects but in others it is not, for the present practice of the United States Patent Office is to refuse to register such a mark, and a mark not registrable here is as a rule not capable of adequate protection abroad. It is fair to say that this is a new policy and may be reversed. Many marks containing pictures of former presidents have been registered.

It is a violation of law, a Federal statute, to use the words "Red Cross" or the symbol of the Greek Red Cross or the Geneva Cross in trade or for the purpose of inducing the sale of any article unless the use of this mark was begun prior to January 5, 1905. The American National Red Cross has now the exclusive right to use these words and this insignia in the United States.

Deceptive Marks.—A mark deceptive in itself or used in connection with deceptive matter is not a valid mark. Courts of equity have consistently refused to sanction a right to impose upon the public. A mark which indicated that a medicine contained a certain valuable ingredient when the fact was that no such ingredient was used in the manufacture of the medicine was denied protection. Such a mark is open to

all infringers. A mark which indicates falsely the place of origin of an article of manufacture is not a valid mark. A mark which indicates that the cigars on which it is used were made in Cuba, when they were manufactured in the United States, is not entitled to protection. A mark which untruthfully states that the soap on which it appears was manufactured in Europe, and which might therefore deceive people from that part of the world into the belief that it was manufactured there, is not a valid mark. A statement contrary to the fact that a brand of whiskey was manufactured in a certain manner and was for this reason of superior quality, prevented the owner of a mark thus falsely used from protecting his trademark.

Fair, honest dealing is a fundamental principle of the law of trademarks. Any conduct which violates this basic idea is abhorrent to the development of this branch of the law. One of the reasons for the increased consideration given each year to the subject of trademarks is that they are especially adapted to fit into the new industrial conditions which are beginning to prevail. Trademarks make for honest dealing, for publicity and for uniform prices to all.

Foreign Words.—A foreign word usually should not be selected as a trademark if the English equivalent would not be a good mark. The fact that a foreign word has a pleasing sound or is attractive to the eye should not weigh in its favor if it is not capable of protection after it has by use and extensive advertising acquired considerable value. "Tipo-Chianti," for a kind of wine, has been held to be an

ordinary Italian word descriptive of the goods upon which it was used and therefore not capable of protection as a valid trademark.

COLOR MARKS

Color marks are particularly desirable in some classes of goods. Such marks are used effectively on hose, rope, and electric conduits. A colored strand placed longitudinally of the goods or helically on them is effective, for no matter what amount is used the mark is still on the goods. A user of such a mark should, however, have a definite color or colors and should uniformly affix them at a certain place so that the public may be definitely advised what mark is claimed. A mark of a certain color—red for instance—according to the holding of some courts, prevents others from using the same mark in any other color. If registration in the United States Patent Office is obtained, it must be for a certain color, definitely located. The Supreme Court of the United States has held invalid the registration of a mark for a streak of distinctive color, the color not being specified, and definitely placed upon the goods.

The color of a conventional package cannot be claimed as a valid mark. The courts do not sanction a claim to a mark which would prevent dealers from using the ordinary colors of wrapping paper or from making a package or receptacle attractive by means of various colored paints.

Words like Red, Yellow and Blue Label, which may designate the color of the package or receptacle or of the goods, should not be selected as trademarks;

nor are colored parts of a structure valid marks if it is common in the trade to which the particular goods relate to paint parts of the goods certain colors. It is very doubtful if the core of a rope of a definite color is a valid mark, in view of the fact that the core of ropes has been made for a long time of material of a certain color, as is shown by the old patents issued for inventions in various styles of rope.

NAME OF A PATENTED ARTICLE

The name by which a patented article is known during the term of the patent is not a valid mark to which the owner has the exclusive right after the expiration of the patent. If a certain name or design has become, while the patent is in force, the identifying designation of the patented device, everyone who wishes to make, use or sell that device after the patent has expired may use the name by which the device has become known. It is true no one will be permitted to use the name of the article on which the patent has expired in such a manner that the purchasing public would be led to believe that the device manufactured by another was manufactured by the patentee, but any one may call his article, manufactured in accordance with the terms of the patent, by the name of the patented article while clearly distinguishing his manufacture by appropriate words from the device manufactured by the former holder of the patent. Thus it was held that after the patent on the Singer sewing machine expired, any one was justified in designating the machine made in accordance with the provisions of the expired patent as a

Singer machine. It therefore follows that the owner of a patent loses, on the expiration of the patent, the exclusive right to the mark which he may have made famous before his patent expired, and can after that date protect his use of the mark only under the doctrine of unfair competition.

The practical question at once arises, How may the patentee, after the patent has expired, maintain the exclusive right to the mark which he used on his patented article while he only could make that article? If the mark used has become the identifying mark, there is no way to do this. To do so would extend the life of the patent monopoly which is contrary to the statutes and the theory of the patent system.

If the mark is used on an article prior to the time when some features of it are made in accordance with the specification of a patent, the expiration of the patent will not generally terminate the right to the trademark. If a device embodies some of the features of several patents, but not all of them, and other devices are made in accordance with different patents and different trademarks are applied to the various devices, the expiration of the patents will not usually terminate the right to the trademark.

This peculiar condition, which rarely occurs, has enabled an inventor to protect his trademark after the expiration of the patent. If the producers of goods of the kind manufactured by the patentee after his patent has expired respect his exclusive use of the mark for a term of years, say eight or ten years, the courts have, at the expiration of that time, com-

pelled others to refrain from using the mark, apparently on the theory that the exclusive use for such a long time had so identified the mark with the former patentee that for anyone else to use it would be a deception of the public. This state of facts rarely exists in trade.

DESCRIPTIVE WORDS AND GEOGRAPHICAL TERMS

No exclusive right can be maintained by anyone to a descriptive word or a geographical term to designate his goods. A word which describes an article of commerce or some characteristic of that article belongs to every one who fairly uses it. It being a well recognized custom in trade to apply the name of the place of production to articles of merchandise, no dealer has the right to prevent others from truthfully using the name of the place of origin of his goods.

The United States Supreme Court in one case pointed out that the words "Iron Bitters" described the ingredients, characteristics and purposes of the goods upon which they were used and could therefore not be a valid trademark. Any other manufacturer of bitters in which iron was an ingredient had the right to say to the public that what he manufactured was iron bitters so long as he did not falsely indicate that his medicine was manufactured by another. The same court has recently said that a merely misspelled descriptive word is not a valid mark.

The same rules apply to geographical terms. "Tabasco," "Columbia," "American" and "Elgin"

have all been decided to be marks to which no one can have an exclusive right. In order to protect his mark fully as a trademark a trader should not use a geographical term.

Some words which indirectly indicate a characteristic of an article are generally regarded by the courts as valid marks. "Ideal," "Excelsior," "Unique," "Holeproof," "Cottolene" and "Elastic" are of this class.

SURNAMES

It is common practice for dealers in some lines of goods to use their names as trademarks. This is not to be recommended. Full protection can not be obtained for a surname mark. While the first to use a surname may prevent another from using his name in such a manner that the ordinary purchaser will be deceived, it is true that the courts find it almost impossible to protect such a mark from all infringement. A plaintiff has the burden of establishing infringement, and it is sometimes better to stand a certain amount of loss of trade rather than to sue for an invasion of one's rights. The best way to avoid such a condition is not to use a mark which can not be satisfactorily protected. The law is thoroughly settled that a personal name is not subject to exclusive appropriation; any one of the name has a right to use it fairly.

Portraits of individuals often become the most valuable marks in use. The picture of Mennen is an enormous asset to the users. The portraits of celebrated individuals are among the most valuable

marks. The Edison and Franklin marks are examples. A picture of a celebrated living individual should, however, not be used without his consent. Some of the states prohibit by special laws the use of the picture of a living individual in trade without his consent, and the United States Patent Office is prohibited by law from registering such a mark without the consent of the person whose picture is used. There are many reasons for using the pictures of deceased celebrities as trademarks. The public has been educated to recognize the picture of such an individual; this is no small advantage. Such a mark is not easily infringed; a picture is or is not the portrait of a celebrity, and there can therefore be very little contention upon the question of infringement. The only deceased celebrities whose pictures may not be registered in the United States Patent Office, as has been stated, are those of former presidents of the United States. It must appeal to every one that the pictures of some celebrated individuals are adapted for use as a mark for certain goods only. Why a picture of a historical character may not be successfully applied to some goods but may be used with others is hard to set out in words, but it will be readily appreciated after some study of the law of trademarks if the characteristics of the person and the goods are taken into consideration.

SIMILAR MARKS IN USE ON THE SAME CLASS OF GOODS

No one should adopt a mark which is already in use on the same general class of goods, for the first

to adopt and continuously use is the owner of the mark. A most important inquiry, then, is whether the mark is in use anywhere in the United States on the class of goods upon which it is desired to use it. One who proposes to use a mark must be the first to use in order to protect it.

If investigation does not show use of the trademark which a trader desires to adopt, then no further inquiry is necessary, but if it is found that it is used it then becomes an important matter to determine whether the goods upon which it is used are of the same general class, or, as some of the statutes state, whether your goods are of the same descriptive properties as the goods of the earlier user of the mark. If they are, then you are not entitled to use the mark. If they are not, you may legally use that mark. Whether another may rightly use upon an entirely different class of goods a mark which has been made famous by extensive advertising and fair dealing admits of doubt. A great many dealers regard as unfair the use of a celebrated mark upon a line of goods entirely different from that upon which the mark has been used. A court of equity will not, however, enjoin the use upon a line of goods so different from that upon which it has been used that the ordinary purchaser will not be led to believe that the original user is the producer or guarantor of those goods; or if the new line of goods is so different that it could not be fairly considered as a natural development of the business of the original user of the mark. Hosiery and knit underwear have been held to be so similar that the first user of a mark on one

of these goods was entitled to prevent another from registering the mark on the other goods. In another case the same court decided that hair pins are not of the same descriptive properties as hooks and eyes and refused to prevent registration to the second to use upon one kind of goods the mark which had been previously used on the other. These are close cases. Usually the question is not very difficult to decide.

In order that there may be no question about the right to use a mark, if use by another of the same mark upon goods of the same general characteristics is found, that mark should not be adopted. Use of a mark about which there is some question should not be begun; there is just as much reason for refusing to take up the use of a mark when the right to its exclusive use is not clear as there is for refusing to buy a piece of real estate to which the title is defective.

USE

In the United States, use determines the right to a mark; intention to use without use is of no value in securing title. What constitutes use is therefore of prime importance. A public declaration that a mark will be used is not sufficient to establish the exclusive right to it; nor does the publication of the mark in a catalogue or trade circular, establish title to it. It must be actually placed upon or associated with the goods as an identifying mark.

A user of a mark in a small way is entitled to the same protection as a large user, the right to a mark

not being determined by the extent of use. The contention that a great corporation which distributes its goods over many states is entitled to a mark which another had earlier used in a small way has not received approval. *Bona fide* continuous use in a small way is entitled to protection.

The right to a mark may be lost by abandonment after use has been established. The right may not be kept if use in trade is discontinued for a number of years unless some particular circumstances are shown which strongly indicate that there was no intent to give up the right to use the mark. Care should be exercised in buying the right to a mark and the business with which it is used to determine that the owner has not stopped using it so long that he has nothing to sell.

ASSIGNMENT

A valid assignment must identify the mark assigned and must convey the good will of the business with which the mark has been used. It is important that a purchaser ascertain that there is a "going business" with which the mark he proposes to buy is used. If there is not, then no valid assignable trademark right exists.

The owner of a trademark who wishes to sell it must not abandon it, but must continue a bona fide use of it until such time as he finds a buyer for the mark and the business with which it is used. The would-be purchaser of a mark should investigate carefully the history and present condition of a mark which he contemplates buying. If the mark was at

one time abandoned, the date of adoption and use may be quite recent, due to the abandonment and subsequent use of the mark. In many cases trademarks are valuable because of the long period they have been validly used. The evidence of an early date of adoption and continuous use should therefore be as carefully investigated as the title to real estate.

What has just been said leads to a consideration of the care which should be given to the preservation of the evidence of adoption and use of a mark. The important evidence of these facts should be carefully kept.

Letters and memoranda which indicate the intent of the parties to adopt a certain mark, orders for cuts or proofs of the mark, bills or receipts showing purchase of labels, stencils or other methods of producing the mark, evidence of the earliest sale of goods with the mark on them, and evidence of continuous use, such as orders, receipts, letters and similar papers, covering regular periods of, say, three to six months, are of this character. Such evidence as this will enable the owner of a mark to establish, when necessary, the date of adoption and continuous use of his mark. Without some such means of showing his right to a mark he may be at the mercy of an infringer when his mark has become valuable. If evidence of the kind specified is kept it will enable him to stand a searching investigation of the title to his mark if he desires to dispose of the business with which his mark has been used.

REGISTRATION

The deposit of evidence showing commercial use of a mark with a government or other agency with a request that a certificate be issued certifying this fact is referred to as an application for registration. The certificate if granted is a certificate of registration. Application for registration may be made to the United States Patent Office, to the proper state officer of most of the states, usually the Secretary of State, and to several private registration bureaus or agencies. The certificate does not constitute title to the mark; it is evidence of a claim to the exclusive right to use the mark upon the goods specified in the certificate.

Registration in the United States Patent Office and the proper state office constitutes a public record of a claim to the mark. This record is more permanent than any private record is likely to be. A copy of it can always be obtained and is usually made prima facie evidence of title to the mark.

Before attempting to make application for registration under the United States trademark law, a copy of the law and rules relating to trademarks should be obtained from the United States Patent Office. These should be read carefully. After becoming familiar with the law, rules, forms and classification, it is not a difficult matter to modify the forms to suit the particular facts applicable to any mark. If it is not clear in what class of merchandise the particular goods should be classified, select the class which describes generally the goods upon which the

mark has been used; if the class selected is not correct, the Patent Office will advise the applicant to give the correct class in an amendment of the application. The important decisions of the Commissioner of Patents bearing on questions which arise under the trademark law are published weekly in the Official Gazette of that office, and in yearly volumes designated as the Decisions of the Commissioner of Patents. These may be consulted by means of digests with much profit upon doubtful points. Many decisions are now annually rendered by the State and Federal courts upon the subject of trademarks and unfair competition.

All marks which the Patent Office regards as registrable are published at least once in the Official Gazette of that office. This gives an opportunity to oppose registration to any one who believes he would be injured. The procedure in such a case and in interference cases is regulated by the rules of the Patent Office and those prescribed for the guidance of the Federal courts so far as applicable.

The notice of registration of a trademark prescribed by the Federal trademark act and the laws of the states under which registration is secured should always be used with the mark. Infringers are often deterred from using a registered mark if the notice of registration appears prominently.

INFRINGEMENT

A trademark is infringed in many ways. The use by another of the identical mark previously adopted and used on the same goods is a direct violation of

the rights of the first user. This character of infringement is not often encountered. The infringer usually adopts a mark slightly different from the valuable mark of another or applies the mark to goods of a somewhat different class. He uses what the courts call a "colorable imitation" of the original mark. This is the class of infringement against which the owner of a trademark must protect himself. How may he do this?

The owner of a mark should not permit his mark or a mark so similar as to cause confusion to be registered in the United States Patent Office for his goods or goods of the same general class. If he is convinced he has a prior right to the mark he may prevent registration by a proceeding known as an opposition, provided for by the trademark act. Although it is not as important to prevent another from obtaining Federal registration if the owner uses his mark only on goods sold in the United States as it is if he ships to foreign countries, it is inadvisable to allow another to secure a certificate which carries with it the presumption of title. If another than the real owner secures registration in the United States he may register his mark in foreign countries, relying on his registration here to perfect it. In the majority of foreign countries the first to register, in the absence of fraud, is entitled to the mark without regard to the earlier use another may prove. If another has secured foreign registration, it is a matter of great difficulty and is sometimes impossible except by agreeing to the terms imposed by the infringer, to obtain the entry of goods into that coun-

try. It is very important, then, to prevent another from securing registration here if that act is followed by registration abroad. Two points should therefore be kept in mind in this connection: (1) An infringer should be prevented from registering your mark, (2) and you should obtain as early as possible registration in those countries in which you may in the near future expect to sell your goods.

Goods bearing a well known mark are often sent into this country by a foreign infringer. In some lines of trade such infringement is persistent. To prevent this and to protect a mark a certificate of the registered mark with sufficient ordinary printed copies should be deposited with the Secretary of the Treasury with a request that copies be sent to the proper custom officer at custom houses in which the infringing goods will probably be entered. Whether state registration is valuable in protecting a mark depends upon the laws of the particular state in which the trader is located.

The owner of a trademark is not required to spend his time hunting for infringement. He is entitled to suppose that his rights are being respected. If he promptly notifies an infringer and requests him to stop as soon as the infringement has been called to his attention he has taken the necessary steps to protect his mark. The notice to cease infringement should, however, be promptly given.

SUIT TO PROTECT A MARK

If an infringer refuses to stop using a mark after notice, no course is open to the owner if he wishes

to protect his mark but to bring suit. Long delay may result in loss of exclusive right to the mark; or if this does not happen the allowance of damages from infringement may be refused. The notice to an infringer to stop use must be followed up; it is better not to give notice to stop infringing unless the notice is enforced.

It is generally advantageous to bring suit in the Federal courts, although this is not always true. The character of the parties, their location, the subject matter and other circumstances must be considered. Suit may be brought in these courts on any mark registered under either of the United States trademark laws. If the mark has not been registered under these laws, whether suit may be brought in the Federal courts depends upon diversity of citizenship and the value of the subject matter of the suit. Suit may of course be brought in the state courts and it is sometimes advantageous to sue in these courts. The character of the trademark laws of the state in which the suit may be brought is often a controlling element.

In an action at law damages may be recovered for the wrongful use of a mark. An injunction to prevent the infringer from continuing the use of the mark is what is ordinarily most desired. A suit in equity in which the grant of an injunction is asked is therefore the usual action taken to stop infringement. The decision of a court holding that the complainant's mark is valid and infringed and an order that the defendant stop infringing, which is referred to as an injunction, are the best means of protection

against loss from the fraudulent use by another of a valid mark.

IMPORTANT QUESTIONS

Whether the owner of a trademark can license another to use his mark upon the same kind of goods upon which he continues to use it without forfeiting any of his rights is a difficult question which has not been satisfactorily settled. There are cases in which the rights of a licensee of a trademark have been protected against a third party; and the licensor of a patent has a right to be protected in the use of a trademark affixed to his patented article; but it is very doubtful whether the right to the exclusive use of a trademark is not lost by the acquiescence of the owner in the use of his mark by another. A trademark is a distinctive mark of ownership which identifies the producer or the party who guarantees the article. If the mark is used by many it ceases to be an identifying mark. It would probably be held that such use was fraudulent. Under the present state of the law, to license the use of a mark jeopardizes the right to its exclusive use.

The question whether a trader may have more than one mark for his goods has been raised, and although there are some decisions of the courts to the effect that one mark only may lawfully be used on one kind of goods, it is now generally acknowledged that two or more marks may be used, either together or separately. A word mark, for instance, may be more attractive to one class of customers and may serve to identify the goods, while

a picture or some artistic design may appeal to another class. There is no good reason why a merchant may not take advantage of two or more methods of identifying his goods. Some users of trademarks have one mark which they place on all their goods, and many others which they use to identify each particular kind. This practice is undoubtedly a good one for the manufacturer or merchant who puts on the market many different varieties of goods all of the same general class.

The manner of advertising a good trademark deserves careful consideration, for it must be brought before the public in a way that compels attention if it is to succeed. This should be kept in mind. Wherever the mark appears, whether on the goods, in newspapers, magazines, circulars or billboard advertising, it should be so used that it will create a definite, cumulative impression. To dress up the mark at one time so that it cannot be recognized as the same mark that is advertised at another time, is wasteful. The attention of the public must be compelled by again and again producing the same impression. A "moving" mark, that is, one which may be changed to excite interest without changing the impression produced, is to be desired. The value of movement is as appreciable in trademarks as in literature.

The practice is growing of having in addition to a trademark, a phrase, or slogan which is used with the mark. This phrase is often descriptive and may be protected by a suit for unfair competition. It adds much to the value of the mark when appro-

priate. Some well known slogans are "Quality is Remembered Long After the Price is Forgotten," "It's the Process," "There's a Reason." A good slogan or advertising phrase helps to advertise and protect a trademark. Trademark owners should by all means adopt a slogan if they have enough genius to discover a good one. It will help to keep off infringers of the trademark with which it is used.

Those who find it advantageous to use trademarks should remember that a complicated mark is not a good mark; it should be simple and clean cut. If a picture is used instead of a word, it should be one that all can readily designate by name. A mark without a name is a weak mark. A word mark should not be one that is difficult to pronounce or which may be pronounced in different ways. People dislike to run the risk of giving a wrong pronunciation to a word, and will often avoid pronouncing such a word; and every time this occurs the user is deprived of some advertising.

One of the most valuable qualities of a trademark is that it acts as a means of establishing for the producer a reputation for his goods directly with the consumer. Without a trademark or the equivalent the manufacturer is at the mercy of the jobber or the retailer.

INTERNATIONAL PROTECTION

Trademark law as well as other branches of the law has been developed and improved by those who plan and work to bring about an ideal condition.

The right to a trademark should not be limited

to any particular country; exclusive right to it should exist wherever the goods upon which it is used are sold. Full protection will not be accorded a trademark until the exclusive right to it is respected everywhere. Full protection cannot now be obtained in all countries without relatively very great expense and trouble. The laws of all countries will some day be so improved that the first to adopt and use a trademark will be given the same rights to his mark in foreign countries as in his own. This will be an ideal condition compared with the present status of this class of property.

A long step in the right direction was made when the articles of the first Convention for the Protection of Industrial Property were adopted at Paris, March 20, 1883. The United States ratified this convention in 1887. It was decided by the Attorney General of the United States, however, that the provisions of the convention are not binding upon this country in the absence of statutory law to carry the various provisions into effect; and not all the provisions have received recognition. In the four conventions held since 1883, the last having been held in Washington in 1911, some important recommendations have been made, but no important legislation in the United States on the subject has been enacted since the trademark law of 1905 was passed.

An International Bureau for the registration of trademarks was established in 1893 under one of the Articles of the International Convention of 1883. This Bureau is located at Berne, Switzerland, and enables the citizens of the countries which are par-

ties to the establishment of it to register their trademarks in those countries by making a single application to their own government with a request that registration be granted in all the countries which are parties to the establishment of the International Bureau. Registration on one application is in this way obtained in the home country and in the other countries of the Union upon the payment of a very small fee in comparison with the total fees charged for independent applications in all the countries. The United States is not a member.

Efforts have been made in America to establish unions and registration bureaus for the protection of trademarks. In 1910 the Fourth International Congress of the American States was held in Buenos Ayres, Argentine, attended by the representatives of twenty nations. This Congress recommended the establishment of registration bureaus at Havana and Rio Janeiro through which registration could be effected in all the states of the Union. Neither of these bureaus have been established.

To establish some method of obtaining international protection of trademarks of the general character presented by these conventions would be most advantageous to all interested in trademarks. Honest dealing and fair trade demand international recognition of the rights of a trademark owner.

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